



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,145	01/31/2002	Takayuki Suzuki	P 284982 SPO-2477	7654

909 7590 04/17/2003

PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

LEE, Y YOUNG

ART UNIT	PAPER NUMBER
----------	--------------

2613

DATE MAILED: 04/17/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

27

Office Action Summary

Application No.
10/059,145

Applicant(s)
Takayuki Suzuki et al

Examiner
Y. Lee

Art Unit
2613



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 31, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-30, 32-34, and 38-53 is/are pending in the application.
- 4a) Of the above, claim(s) 18-30, 32-34, 38-47, and 50-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/805,477.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 6) ☐ Other:

Art Unit: 2613

DETAILED ACTION

Interview Summary

During two telephone conversations with Mr. Henry Daley on 3/11/03 and Mr. Jason Skaarup on 3/25/03, Examiner was informed that applicant intends to file a supplemental amendment in order to submit generic claims to embodiments 2 and 3 of the invention.

Election/Restriction

1. Newly submitted/amended claims 18-30, 32-34, 38-47, and 50-53 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: originally filed claims 18-37 were directed to the third embodiment whereas newly amended and added claims are switched to the second embodiment.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-30, 32-34, 38-47, and 50-53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

Art Unit: 2613

amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copy has been filed in parent Application No. 08/805,477, filed on 2/25/97.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 48 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiyama et al (5,436,655).

Hiyama et al, in Figures 18, 21, 66, and 76, discloses the same TV observation system for an endoscope as specified in claims 48 and 49 of the present invention, comprising an endoscope 202 ; and a small-sized light source unit (217, 244, 247) comprises at least two of a shortened light guide cable 217, a plurality of LEDs, a compounding optical system 242 configured to compound light emitted by the plurality of LEDs and a power supply 243; an

Art Unit: 2613

attachment TV camera 701; wherein the proximal holding part is provided with an eyepiece section 718b, the attachment TV camera 701 is constructed and arranged to removably mount on the eyepiece section 718b, the power supply is arranged in a TV processor 737 which displays electric signals from the TV camera, and a power line is arranged, along with a signal cable of the TV camera 734, to connect the attachment TV camera 701 and the TV processor 737.

wherein the endoscope 202 is structurally separated into an insertion part 207 and a proximal holding part 205 continuously extending from the insertion part 207; wherein the endoscope 202 comprises a light guide 217 arranged from a distal end of the insertion part 207 through the proximal holding part 205; wherein the proximal holding part 205 is provided with a light guide joint section 218 where an entrance end face of the light guide 217 is fixed; wherein the small-sized light source unit 205 is constructed and arranged to be removably connected with the attachment TV camera 734.

Response to Arguments

6. Applicant's arguments filed 3/31/03 have been fully considered but they are not persuasive.

Art Unit: 2613

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications; please mark "EXPEDITED
PROCEDURE")

(for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Art Unit: 2613

Or:

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington. VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (703) 308-7584.



**Y. LEE
PRIMARY EXAMINER**

Y. Lee/yl
April 15, 2003